

GAV 3743

PATENT
01634-P0026C LHR

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	Andrew I. Lemont, <i>et al.</i>
Serial No. 09/208,185	Filing Date: September 14, 2000
Title of Application	Active Heat Sink Structure with Flow Augmenting Rings and Method for Removing Heat
Group Art Unit 3743	Examiner Leonard R. Leo

Assistant Commissioner for Patents
Washington, DC 20231
ATTENTION: Group Director, Group 3743
(M.P.E.P. § 1002.02(C))

Request For Reconsideration of Holding of Abandonment (M.P.E.P. § 711.03(a))

Dear Sir:

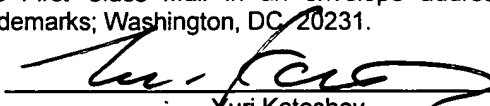
Applicants through their dully appointed attorney hereby respectfully request reconsideration of holding of abandonment issued on July 17, 2000. (attached as Exhibit A.)

The Examiner asserted that a timely filed response, which was filed June 8, 2000, to Final Office Action of December 10, 1999 (attached as Exhibit B) contained a defective terminal disclaimer (attached as Exhibit C). The response contained a check for \$435.00 (attached as Exhibit D), the terminal disclaimer accompanied by a check for \$55.00 (attached as Exhibit F) in compliance with 37 CFR 1.321, and a petition for an extension of time (attached as Exhibit E),.

The terminal disclaimer correctly identified Patent Application Serial Number (09/208,185), but incorrectly pointed out a filing date as 988/12/09 instead of 1988/12/09 in the body of the disclaimer.

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September 14, 2000


Yuri Kateshov

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Page 2

Serial No. - Pending

Applicants: Andrew I. Lemont, et al.

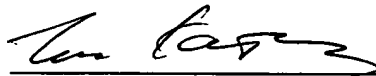
Applicants assert that the terminal disclaimer was proper on its face since the application number was correctly identified. The filing date of the patent application in question was correctly identified in the caption part of the disclaimer, which was drafted in compliance with PTO/SB/26B.

Furthermore, Applicants contacted the Examiner immediately after they had learned about the abandonment and, following Examiner's suggestion, filed the revised text of the terminal disclaimer. (attached as Exhibit G.)

Replies by Applicants were a bona fide attempt to advance the application to issue, and were substantially complete. It seems unfair to punish Applicants for something that cannot be even characterized as a clerical mistake since there is no established standard with which the terminal disclaimer should comply.

Therefore the holding of abandonment should be withdrawn, the proposed response should be considered on its merits and the claims remaining in this case should be allowed.

Respectfully submitted,



Yuri B. Kateshov, Registration No. 34,466
Attorney for Applicants
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155

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Exhibit A

Notice of Abandonment

SEP 18 2000

Application No.

09/208,185

Applicant(s)

Lemont et al.

Examiner

Leonard R. Leo

Group Art Unit

3743



This application is abandoned in view of:

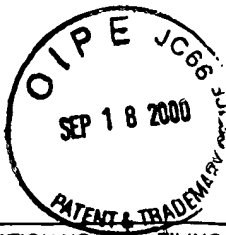
- ☒ applicant's failure to timely file a proper response to the Office letter mailed on Dec 10, 1999.
 - ☐ A response (with a Certificate of Mailing or Transmission of _____) was received on _____, which is after the expiration of the period for response (including a total extension of time of _____ month(s)) which expired on _____.
 - ☒ A proposed response was received on Jun 12, 2000, but it does not constitute a proper response to the final rejection.
(A proper response to a final rejection consists only of: a timely filed amendment which places the application in condition for allowance; a Notice of Appeal; or the filing of a continuing application under 37 CFR 1.62 (FWC)).
 - ☐ No response has been received.
- ☐ applicant's failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance.
 - ☐ The issue fee (with a Certificate of Mailing or Transmission of _____) was received on _____.
 - ☐ The submitted issue fee of \$ _____ is insufficient. The issue fee required by 37 CFR 1.18 is \$ _____.
 - ☐ The issue fee has not been received.
- ☐ applicant's failure to timely file new formal drawings as required in the Notice of Allowability.
 - ☐ Proposed new formal drawings (with a Certificate of Mailing or Transmission of _____) were received on _____.
 - ☐ The proposed new formal drawings filed _____ are not acceptable.
 - ☐ No proposed new formal drawings have been received.
- ☐ the express abandonment under 37 CFR 1.62(g) in favor of the FWC application filed on _____.
- ☐ the letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
- ☐ the letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
- ☐ the decision by the Board of Patent Appeals and Interferences rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
- ☐ the reason(s) below:

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Leonard R. Leo

LEONARD R. LEO
PRIMARY EXAMINER
ART UNIT 3743

Exhibit B



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/208,185 12/09/98 LENONT

A 01134-P00260

QM02/1210

LOUIS H REENS
ST ONGE STEWARD JOHNSTON & REENS
986 BEDFORD STREET
STAMFORD CT 06905-5619

EXAMINER

LED, L

ART UNIT

PAPER NUMBER

3743

DATE MAILED:

12/10/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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St. Onge Steward Johnston & Reens

LHR DEC 14 1999

FILE 2-10-00 *Ans FR*

DKT 3-10-00

6-10-00

✓ Appeal
✓ 6 mos Sp

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Office Action Summary

Application No.
09/208,185

Applicant(s)

Lemont et al

Examiner

Leonard R. Leo

Group Art Unit

3743



☒ Responsive to communication(s) filed on Sep 13, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-6, 16-18, and 21-28 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-6, 16-18, and 21-28 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 3743

Claims 1-6, 16-18 and 21-28 are pending.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.d. 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321[®] may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 16-18 and 21-28 are rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 5,896,917 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

A heat sink for a heat generating device comprising: a heat conducting body and a main air flow passageway.

Art Unit: 3743

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.


The rejection in view of Wang and Minakami et al are withdrawn.

The double patenting rejection is maintained. A properly filed terminal disclaimer will overcome this rejection. See MPEP 804.02 (IV)

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Leonard R. Leo whose telephone number is (703) 308-2611.


LEONARD R. LEO
PRIMARY EXAMINER
ART UNIT 3743

December 6, 1999

Notice of References CitedApplication No.
09/208,185Applicant(s)
Lemont et alExaminer
Leonard R. LeoGroup Art Unit
3743

Page 1 of 1

U.S. PATENT DOCUMENTS

	DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS
A	5,896,917	4/1999	Lemont et al.	165	80.3
B	5,707,205	1/1998	Otsuka	361	695 X
C					
D					
E					
F					
G					
H					
I					
J					
K					
L					
M					

FOREIGN PATENT DOCUMENTS

	DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUBCLASS
N						
P						
Q						
R						
S						
T						

NON-PATENT DOCUMENTS

	DOCUMENT (Including Author, Title, Source, and Pertinent Pages)	DATE
U		
V		
W		
X		

Exhibit C



PATENT
01634-P0026C LHR/YBK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	Andrew I. Lemont, <i>et al.</i>
Serial No. 09/208,185	Filing Date: 1998/12/09
Title of Application	Active Heat Sink Structure with Flow Augmenting Rings and Method for Removing Heat
Group Art Unit 3743	Examiner Leonard R. Leo

Assistant Commissioner for Patents
Washington, DC 20231

***Terminal Disclaimer To
Obviate A Double Patenting Rejection (37 CFR 1.321(b))***

Dear Sir:

The undersigned, Louis H. Reens, declares that:

1. I am the attorney of record in the subject patent application.
2. The assignee is Lemont Aircraft Corporation located at 350 East Main Street; Ansonia, 06401. Lemont Aircraft Corporation is the owner of 100% of the rights, title and interest in and to Patent Application Serial No. 09/208,185 filed 998/12/09 for "Active Heat Sink Structure with Flow Augmenting Rings and Method for Removing Heat" and, to the best knowledge and belief of the undersigned, is believed to be the owner of record of U.S. Patent Application 08/763,483 filed December 11, 1996 and issued as U.S. Patent 5,896,917 on April 27, 1999 for "Active Heat Sink Structure with Flow Augmenting Rings and Method for Removing Heat" by virtue of an assignment as recorded at the United States Patent Office on December 11, 1996, at Reel 008364, Frame: 0001.

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June 8, 2000


Joanne M. Cassone

3. Lemont Aircraft Corporation hereby disclaims the terminal part of the term of any patent granted on Application Serial No. 09/208,185 which would extend beyond the expiration date of the full statutory term of U.S. Patent 5,896,917.

4. Lemont Aircraft Corporation hereby agrees that any patent granted on Application Serial No. 09/208,185 shall be enforceable only for and during such period that the legal title to the U.S. Patent 5,896,917 shall be the same as the legal title to all patents issuing on said Application Serial No. 09/208,185, this Agreement to run with any patent granted on said Application Serial No. 09/208,185 and to be binding upon Lemont Aircraft Corporation, its representatives, successors, and assigns.

5. Lemont Aircraft Corporation does not disclaim any terminal part of any patent granted on said Application Serial No. 09/208,185 prior to the expiration date of the full statutory term of U.S. Patent 5,896,917. In the event that U.S. Patent 5,896,917 either expires for failure to pay a maintenance fee, or is held unenforceable, or is found invalid, or is statutorily disclaimed in whole or hereafter terminally disclaimed under 37 CFR § 321(a), or has all claims cancelled by a re-examination certificate, or is otherwise terminated prior to expiration of its statutory term, except for the separation of legal title stated above.

6. Enclosed is a check in the sum of \$55.00. If there is any fee deficiency, please charge Account No. 19-4516.

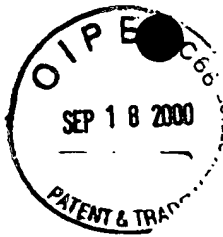
7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,



Louis H. Reens, Registration No. 22,588
Yuri B. Kateshov, Registration No. 44,268
Attorneys for Applicants
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155

Exhibit D



ST. ONGE STEWARD JOHNSTON & REENS LLC

038907

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& REENS LLC

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STAMFORD, CT 06905

Fleet Bank
Stamford, Connecticut

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CHECK NO. 38907

038907

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TO THE
ORDER
OF

Commissioner of Patents & Trademarks
Washington, D.C. 20231

DATE AMOUNT
06/08/00 *\$435.00*

⑈038907⑈ ⑆011900571⑆ 0001 51059⑈

Exhibit A



PATENT
01634-P0026C LHR

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	Andrew I. Lemont, <i>et al.</i>
Serial No. 09/208,185	Filing Date: December 9, 1998
Title of Application:	Active Heat Sink Structure with Flow Augmenting Rings and Method for Removing Heat
Group Art Unit: 3743	Examiner: Leonard R. Leo

BOX FEE AMENDMENT
Assistant Commissioner for Patents
Washington, DC 20231


***Response Transmittal and
Petition For Time Extension (37 CFR 1.136(A))***

Dear Sir:

1. This is a petition for an extension of the time for a total period of Three Months to respond to the Office Letter mailed on December 10, 1999.
2. A response in connection with the matter for which this extension is requested is filed herewith.
3. Applicant is a small entity. A verified statement has been filed.
4. Calculation of extension fee (37 CFR 1.17). \$435.00 Extension Fee is due with this request.

Certificate of Mailing: I hereby certify that this correspondence is today being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents; Washington, DC 20231.

June 8, 2000


Joanne M. Cassone

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5. Fee Payment. Attached is a check in the sum of \$435.00. This is also a petition and a request to charge to Account No. 19-4516 for any additional extension and/or fee as may be required or credit for any excess fee paid.

Respectfully submitted,



Louis H. Reens, Registration No. 22,588
Yuri B. Kateshov, Registration No. 34,466
Attorneys for Applicants
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street; Stamford, CT 06905-5619
203 324-6155

Exhibit F



ST. ONGE STEWARD JOHNSTON & REENS LLC

038908

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06/08/00 OPER-JMC 55.00 01634-P0026C

55.00

**ST. ONGE STEWARD JOHNSTON
& REENS LLC**

986 BEDFORD STREET
STAMFORD, CT 06905

Fleet Bank
Stamford, Connecticut

51-57
119

CHECK NO. 38908

038908

FIFTY FIVE AND 00/100 DOLLARS

DATE

AMOUNT

06/08/00 *\$55.00*

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TO THE
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Commissioner of Patents & Trademarks
Washington, D.C. 20231

⑈038908⑈ ⑆011900571⑆ 0001 51059⑈

Exhibit G



PATENT
01634-P0026C LHR/YBK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	Andrew I. Lemont, <i>et al.</i>
Serial No. 09/208,185	Filing Date: 1998/12/09
Title of Application	Active Heat Sink Structure with Flow Augmenting Rings and Method for Removing Heat
Group Art Unit 3743	Examiner Leonard R. Leo

Assistant Commissioner for Patents
Washington, DC 20231

***Terminal Disclaimer To
Obviate A Double Patenting Rejection (37 CFR 1.321(b))***

Dear Sir:

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July 6, 2000

Joann M. Cassone

3. Lemont Aircraft Corporation hereby disclaims the terminal part of the term of any patent granted on Application Serial No. 09/208,185 which would extend beyond the expiration date of the full statutory term of U.S. Patent 5,896,917.

4. Lemont Aircraft Corporation hereby agrees that any patent granted on Application Serial No. 09/208,185 shall be enforceable only for and during such period that the legal title to the U.S. Patent 5,896,917 shall be the same as the legal title to all patents issuing on said Application Serial No. 09/208,185, this Agreement to run with any patent granted on said Application Serial No. 09/208,185 and to be binding upon Lemont Aircraft Corporation, its representatives, successors, and assigns.

5. Lemont Aircraft Corporation does not disclaim any terminal part of any patent granted on said Application Serial No. 09/208,185 prior to the expiration date of the full statutory term of U.S. Patent 5,896,917. In the event that U.S. Patent 5,896,917 either expires for failure to pay a maintenance fee, or is held unenforceable, or is found invalid, or is statutorily disclaimed in whole or hereafter terminally disclaimed under 37 CFR § 321(a), or has all claims cancelled by a re-examination certificate, or is otherwise terminated prior to expiration of its statutory term, except for the separation of legal title stated above.

6. Enclosed is a check in the sum of \$55.00. If there is any fee deficiency, please charge Account No. 19-4516.

7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,



Louis H. Reens, Registration No. 22,588
Yuri B. Kateshov, Registration No. 44,268
Attorneys for Applicants
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155